

REMARKS

The following remarks are provided in response to the Office Action mailed March 22, 2005 in which the Examiner:

- objected to Figure 1 for omitting a legend;
- objected to the Specification for various informalities
- objected to claim 11 under 37 C.F.R. §1.75(c) as being in improper form
- rejected claims 1-3, 6-9, and 12 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,594,731 to Andrews et al. (hereinafter Andrews); and
- rejected claims 4, 5, and 10 under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of admitted prior art.

The applicant respectfully requests reconsideration of the above referenced patent application in view of the remarks set forth herein, and respectfully requests that the Examiner withdraw all rejections.

Drawing Objection

The Examiner objected to Figure 1 for omitting a legend. In particular, the Examiner suggested that Figure 1 be amended to include the legend "Prior Art." The applicant submits herewith a replacement Figure 1.

Specification Objection

The Examiner objected to the specification for various informalities. In particular, the Examiner objected to the specification for referring to the claims by number. The

applicant herein amends the specification to remove reference within the specification to particular claims.

Claim Objection

The Examiner objected to claim 11 under 37 C.F.R. §1.75(c) as being in improper form. The applicant herein cancels claim 11.

35 U.S.C. §102(b)

The Examiner rejected claims 1-3, 6-9, and 12 under 35 U.S.C. §102(b) as being anticipated by Andrews. For at least the following reasons the applicants traverse the Examiner's rejection.

To establish a *prima facie* case of anticipation under 35 U.S.C. §102, the Examiner must supply a single prior art document that alone teaches “. . . **every** aspect of the claimed invention either explicitly or impliedly.” (emphasis added) (See M.P.E.P. §706.02) If the Examiner cannot show that the single prior art document asserts each and every element and limitation of the applicants' claims, then the Examiner has failed to establish a *prima facie* case of anticipation for that claim. To overcome the Examiner's anticipation rejection, the applicant must only demonstrate that the cited prior art document fails to teach one element or limitation present in the claim.

The applicant herein cancels claims 1-13 and adds new claims 13-25. The applicant will respond to the Examiner's rejection with reference to new independent claims 13 and 20. New independent claim 13 recites in a salient portion:

. . . **phase locking the clock signal (Ck_{out}) to the data signal** by measuring a phase difference between the clock signal (Ck_{out}) and the data

signal and by time delaying the clock signal (Ck_{out}) in response to the phase difference;
(emphasis added)

The Examiner alleges with respect to canceled claim 1 that Andrews column 5 lines 9-33 teach that a phase shift is determined using the clock signal and the received data signal and that the phase shift is used to time delay the recovered clock signal. The applicant asserts however that Andrews column 5 lines 9-33 teach that the SAW filter can be adjusted by trimming to provide the desired, and thereafter nonadjustable, phase shift. The applicants affirm that trimming is a once-only event after which the SAW filter can no longer be adjusted according to Andrews.

For example, column 5 lines 45-48 recite that “. . . SAW filter 22 can be made with a positive (or negative) temperature coefficient (of phase) which allows $\Delta\Phi$ to more closely match the rest of the integrated circuit's temperature dependence.” Further column 5 lines 52-54 recite that “. . . a SAW filter with the necessary phase adjustment $\Delta\Phi$ may simply be dropped into place in the circuit at the end of the process.” Finally, column 5 lines 58-62 recite that “[o]nce the desired phase adjustment is known, a SAW filter is selected from the bin having the closest manufactured phase delay and the [sic] trimmed slightly to provide the needed value.”

Accordingly, the SAW filter according to Andrews cannot teach phase locking the clock signal (Ck_{out}) to the data signal as recited by new independent claim 13 because the phase delay of the Andrews SAW filter cannot, during operation, dynamically adjust its phase delay to accommodate a dynamically fluctuating phase difference between the two signals as required to phase lock the two signals. The applicant therefore asserts that new independent claims 13 and 20 are patentable as each recites at least an element not taught

by Andrews. The applicants further assert that new dependent claims 14-19 and 21-25 are also patentable as each depends from a patentable independent claim.

35 U.S.C. §103(a)

The Examiner rejected claims 4, 5, and 10 under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of admitted prior art. For at least the reasons provided with respect to the Examiner's §102 rejection, the applicant asserts that new independent claims 13 and 20 are patentable as each recites at least an element not taught by Andrews in view of admitted prior art. As new dependent claims 14-19 and 21-25 depend from nonobvious independent claims, the dependent claims are also nonobvious. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

CONCLUSION


For at least the foregoing reasons, the applicant submits that he has overcome the Examiner's rejections and that he has the right to claim the invention as set forth in the listed claims.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Dated _____



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